

REMARKS

With entry of this amendment, claim 60 has been cancelled, thereby leaving claims 2-4, 9-13, 17, 27, 29, 30, 32, 34, 35, 37, 39, 40, 42, 45-59, 61, 62, and 64-76 pending in this application. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Objections

Claim 3 stands objected to under 37 C.F.R. §1.75 as being a substantial duplicate of claim 4. Applicant respectfully traverses this objection, since claim 3 specifically requires a "tissue sensing element," where as claim 4 does not.

Notably, MPEP §608.01(n)(III) states "[t]he test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Claim 4 requires the operative element to comprise "one or more of a tissue ablation element and a tissue sensing element," which means that this claim could be potentially infringed if an operative element only includes a tissue ablation element, or the operative element only includes a tissue sensing element, or the operative element includes both a tissue ablation element and a tissue sensing element. Thus, with respect to this element, claim 4 can be infringed any one of three ways.

Claim 3 specifically requires that the operative element comprise a tissue sensing element, which means that this claim could be potentially infringed if the operative element only includes a tissue sensing element, or the operative element includes both a tissue

ablation element and a tissue sensing element. Thus, with respect to this element, claim 3 can only be infringed any one of two ways.

In other words, an operative element that comprises a tissue ablation element, but not a tissue sensing element, could potentially infringe claim 4, but not claim 3. Thus, claim 3 clearly further limits claim 4.

Thus, Applicant submits that claim 3 is not substantially identical to claim 4, and as such, respectfully request withdrawal of the objection of claim 3.

Claim Rejections

Claims 32, 34, 54, and 56 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 6,027,497 ("Daniel"). Claims 27 and 30 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Patent No. 6,645,202 ("Pless"). Claims 27, 29, 30, and 60 stand rejected under 35 U.S.C. §103, as being obvious over Daniel. Applicant respectfully traverses these rejections, since neither of Daniel and Pless discloses, teaches, or suggests the combination of elements required by these claims, as amended.

In particular, independent claims 30, 32, and 34 have been amended to include what Applicant believes are patentable features. For example, claims 32 and 34 have been amended to require the operative element to comprise an expandable-collapsible body—a feature found by the Examiner to be the patentable feature in independent claim 4. Claim 30 has been amended to require the shroud to include a plurality of vacuum ports and the method to comprise applying a vacuum force to the vacuum ports of the shroud—features not found in Daniel or Pless.

Thus, Applicant submits that claims 30, 32, and 34, as well as the claims depending therefrom (claims 27, 29, 54, 56, and 60), are patentable over Daniel and Pless.

Allowable Subject Matter

Applicant graciously acknowledges the Examiner's allowance of claims 2, 4, 9-13, 17, 35, 37, 39, 40, 42, 45-53, 55, 57-59, 61, 62, and 64-73.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

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Dated: March 10, 2008

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